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10/633,759

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Theodore R. Flint

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09/30/2005

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EXAMINER

SELLERS, ROBERT E

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/633,759

Applicant(s)

FLINT ET AL.

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/3/2003.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

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Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8 and 10-17, drawn to a composition comprising a liquid epoxy resin and a non-sensitizing mercaptan, classified in class 528, subclass 421.
- II. Claim 8, drawn to a composition comprising a first band prepared from a liquid epoxy resin and a second band of a non-sensitizing mercaptan, classified in class 428, subclass 413.

1. The inventions are distinct from each other because the combination of first and second bands of Group II can be formulated with a materially different second band from the non-sensitizing mercaptan of Group I, such as a polyamidoamine.

Restriction for examination purposes as indicated is proper because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification.

During a telephone conversation with Richar A. Paikoff on August 22, 2005, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8 and 10-17. Affirmation of this election must be made by applicant in replying to this Office action. Claim 9 is withdrawn from further consideration under 37 CFR 1.142(b) as being drawn to a non-elected invention.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8, 10-15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Jorissen et al. Patent No. 5,548,026.

2. Jorissen et al. (col. 3, lines 4-10) discloses a two-part epoxy adhesive wherein the first part comprises a sorbitol epoxy resin in an amount of from 1 to 25 wt% (col. 4, line 63 to col. 5, line 16), a curing agent such as a polymercaptan (col. 6, line 40) and a pigment such as titanium dioxide or carbon black (col. 9, lines 56-57).

Claims 1-3, 5, 7, 10-12, 14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent No. 1-249828 (Japanese '828).

3. The abstracts for Japanese '828 set forth a putty consisting of from 5-80 wt% of an epoxy resin having an epoxy equivalent weight of as high as 450 which converts to a molecular weight of 900 for an epoxy resin with two epoxy groups per molecule, a polymercaptan curing agent and a pigment.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese '828 as applied to the claims hereinabove, and further in view of Jorissen et al.

4. The references are described hereinabove. It would have been obvious to employ the titanium dioxide or carbon black as the pigment of Japanese '828 in order to color the putty.

Claims 1-8 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent No. 2-108533 (Japanese '533), Miyamoto Publication No. 2004/0006944, Japanese Patent No. 61-138232 (Japanese '232), Yamamoto Patent No. 6,770,957 and Japanese Patent No. 61-185526 (Japanese '526) *in view of* Jorissen et al.

5. The abstracts for Japanese '533 report a two-composition putty prepared from an epoxy resin and a polymercaptan curing agent.

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6. Miyamoto shows a two-liquid putty (page 6, paragraph 80, the last three lines) obtained from an epoxy resin, more preferably a polymercaptan curing agent (page 3, paragraph 53) and a coloring pigment (page 4, paragraph 56, line 4).

Patentee ascribes high contamination resistance against staining from fine dusts and oils, quick curing and less susceptibility to dimensional contraction, and superior external appearance to the polymercaptan curing agent (page 3, paragraph 53).

7. The Derwent abstract for Japanese '232 espouses a paste containing an epoxy resin, a polythiol and an inorganic filler.

8. Yamamoto is directed to a pasty adhesive composed of a liquid epoxy resin (col. 3, lines 22-24), a polymercaptan hardener (col. 7, lines 53-55) and titanium dioxide (cols. 5-6, Examples 4, 7 and 9).

9. The Derwent abstract for Japanese '526 describes a two-part paste containing an epoxy resin, a polythiol curing agent and a zinc oxide-type phosphorescent pigment.

10. The claimed epoxy resin having a molecular weight of greater than about 700 such as the sorbitol polyglycidyl ether of claims 6 and 15 is not recited. Jorissen et al. is described hereinabove.

11. It would have been obvious to use the sorbitol polyglycidyl ether of Jorissen et al. as the epoxy resin of Japanese '533, 232 and '526, Miyamoto and Yamamoto in order to "provide rapid cure, good adhesion, and impact resistance over time (Jorissen et al., col. 5, lines 6-11)."

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Claims 7 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jorissen et al. as applied to the claims hereinabove, and further in view of Japanese '533 and Miyamoto.

12. Jorissen et al. does not specify the rheology of the adhesive as the putty of claims 7 and 22. Japanese '533 and Miyamoto is described hereinabove. It would have been obvious to formulate the adhesive of Jorissen et al. in the form of a putty as taught by Japanese '533 and Miyamoto in order to facilitate the handling and application of the adhesive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers  
Primary Examiner  
Art Unit 1712

rs  
9/27/2005